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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,603	02/28/2002	Kyoko Kobayashi	0992-0128P	3606
2292	7590	06/30/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			VO, HAI	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 06/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/069,603

Applicant(s)

KOBAYASHI ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-13, 15-40 and 42-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-13, 15-40 and 42-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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1. The art rejections over EP 974 617 in view of EP 976 782 are maintained.
2. The indicated allowability of claim 14 is withdrawn. Claim 14 should be rejected over EP 974 617 and EP 976 782 (see discussions below).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20, 27-35, 37 and 47 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases "consisting of" and "optionally at least one of" render the claims indefinite because they are not consistent to each other. It is not clear how the skin layer may further include additional materials when it is limited to "an ultrahigh molecular weight polyolefin resin (Y)" only.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-13, 15-40, and 42-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 974 617 in view of EP 976 782 substantially as set forth in the 12/15/2004 Office Action. Yorita et al (US 6,303,666) ("Yorita") is relied on as an equivalent form of EP 976 782.

**Examiner's comments regarding claims 4 to 19, 38 to 40 and 42 to 46:**

Applicants argue that EP'782 discloses that a cross-linked olefinic copolymer (A-3)(a) and a decomposable olefinic plastic resin (A-3) (b) are subjected to dynamic crosslinking in the presence of a crosslinking agent. Therefore, Applicants assert that there is no suggestion to subject a mixture of polyethylene resin (a-1) and copolymer based on ethylene/ $\alpha$ -olefin (a-2) to a dynamic heat treatment in the absence of a crosslinking agent to obtain an ethylenic thermoplastic elastomer (A) as in the present invention. The examiner disagrees. Applicants' attention is directed to the comparison as follows:

<b>Yorita (US'666)</b>	<b>Claimed invention</b>
Crosslinked olefinic copolymer (A-3)(a)	ethylene/ $\alpha$ -olefin copolymer (a-2)
Olefinic plastic (B)	polyethylene resin (a-1)

It is agreed that the cross-linked olefinic copolymer (A-3)(a) and a decomposable olefinic plastic resin (A-3)(b) are subjected to dynamic crosslinking in the presence of a crosslinking agent. The arguments are not found persuasive for patentability for two reasons. First, the decomposable olefinic plastic resin (A-3)(b) is chemically different from the olefinic plastic (B). Second, the olefinic plastic (B) is added to the admixture **after** the cross-linked olefinic copolymer (A-3)(a) is already prepared so as to eliminate the thermal decomposition and crosslinking of olefinic copolymer A-3)(a) by heat, thereby obtaining an expanded product as intended (column 13, lines 25-35). Since the olefinic copolymer (A-3)(a) is already crosslinked before kneaded under heat with the olefinic plastic (B), no cross-linking

agents are required when the admixture of the olefinic plastic (B) and the crosslinked olefinic copolymer (A-3)(a) are subjected to the dynamic heat treatment.

**Examiner's comments regarding claims 10, 27 to 35, 37 and 47:**

Applicants argue that the ultrahigh molecular weight polyolefin resin (Y) to be used as the skin layer of foamed laminate defined by claims 20 and 47 is not a thermoplastic elastomer obtained by complete or partial crosslinking and is different from the olefinic thermoplastic elastomer (A) of EP'617. The examiner disagrees. The language "consisting of" and "optionally at least one" together is treated as "comprising". Claim 20 does not exclude an embodiment where the skin layer comprises a filler which is a thermoplastic elastomer obtained by complete or partial crosslinking. Further, claim 20 does not exclude an embodiment where the skin layer comprises a lubricant which is a higher viscosity polysiloxane (B) and a lower viscosity polysiloxane (C). The skin layer consisting of an ultrahigh molecular weight polyolefin resin (Y) and nothing else renders the application unobvious over the prior art.

**Examiner's comments regarding claims 21 to 26, 36 and 48 to 51:**

Applicants argue that the use of a foamed olefin core has unexpectedly superior properties to the solid core of EP'617 as modified by Yorita with respect to amount of wear and the sponge touch of the inventive laminate. The arguments are not found persuasive for patentability because they are not commensurate in scope with the basis of the art rejections. Tables 2 and 3 of Applicants' specification demonstrate that the use of a foamed olefin core made from olefinic thermoplastic

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elastomers (J-1) and (K-1) has unexpectedly superior properties to the solid core of an olefinic thermoplastic elastomer (J-1) which not the solid core of olefinic thermoplastic elastomers (J-1) and (K-1) as formulated in the art rejections over EP'617 in view of Yorita. Therefore, what shown in tables 2 and 3 does not demonstrate the unexpected results over the prior art as asserted by Applicants. Accordingly, the art rejections are thus sustained.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Hai Vo*

**HAI VO  
PRIMARY EXAMINER**